



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,804	08/05/2003	Yue Jun Jiang	RMWR.P010	8833

7590 05/23/2005

Shemwell Gregory & Courtney LLP
Suite 201
4880 Stevens Creek Boulevard
San Jose, CA 95129

EXAMINER

CAI, WAYNE HUU

ART UNIT	PAPER NUMBER
----------	--------------

2681

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,804

Applicant(s)

JIANG ET AL.

Examiner

Wayne Cai

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/05/2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
4a) Of the above claim(s) 13-25 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/6/04, 1/11/05
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: 4/7/05

DETAILED ACTION

Election/Restrictions

1. The examiner called Barbara Courtney (Registration No. 42,442) on 05/10/2005.

The attorney makes an election with traverse of claims 1-12 in the reply is acknowledged.

2. This application contains claims directed to the following patentably distinct species of the claimed invention:

I. Claims 2-12 are related to selecting a preferred network over a non-preferred network.

II. Claims 14-20 are related to detecting a Subscriber Identity Module toolkit application and updating information on the SIM.

III. Claims 22-25 are related to different modes in a system for directing wireless network traffic.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 13, and 21 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Drawings

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the submitted drawings are not formal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

4. Claims 1, 4, 6, 10, and 11 are objected to because of the following informalities:

Claim 1, line 4, "to initiate a registration" should be corrected as - -to initiate the registration- -

Claim 4, line 3, "a non-preferred network" should be corrected as - -the non-preferred network- -

Claim 4, line 5, "to reinitiate a registration attempt with a preferred network" should be corrected as - - to reinitiate the registration attempt with the preferred network- -

Claim 6, line 2, "a non-preferred network" should be corrected as - -the non-preferred network- -

Claims 10 and 11, line 1, "a roaming mobile station" should be corrected as - - the roaming mobile station- -

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Huang et al (hereinafter Huang) (US – 6,058,309).

Regarding claim 1, Huang discloses a method for controlling wireless network traffic, comprising:

- determining when a roaming mobile station initiates a registration attempt with a non-preferred network (col. 3, lines 50-64);
- causing the roaming mobile station to initiate a registration attempt with a preferred network (col. 3, line 65 – col. 4, line 33).

Regarding claim 2, Huang discloses the method of claim 1 as described above. Huang further discloses determining what network the mobile station is currently registered with (col. 3, lines 49-55).

Regarding claim 3, Huang discloses the method of claim 1 as described above. Huang further discloses preventing the mobile station from succeeding in the registration attempt with the non-preferred network (col. 3, line 65 – col. 4, line 7). The examiner notes that the VLR-2 prevents the MS from registering with the network by sending a message to the HLR to determine another preferable system.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang.

Regarding claims 6, 7, and 9, Huang discloses the method of claim 1 as described above. Huang also discloses determining whether the registration attempt with a non-preferred network is allowed to succeed (col. 5, line 45 – col. 6, line 7). Huang, however, does not teach if the registration attempt is not allowed to succeed, rejecting the attempt. Nonetheless, it is well known in the art that once the mobile station is required to authenticate, but it is not allowed to succeed; it must be rejected for attempting to register with the network and the message is also transmitted in response to the registration request.

9. Claims 4, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Sorenson et al (hereinafter Sorenson) (US – 6,463,298 B1).

Regarding claim 4, Huang discloses the method of claim 1 as described above. Huang also discloses determining that the mobile station is registered with a non-preferred network (col. 3, line 65 – col. 4, line 33). Huang, however, fails to disclose wherein the registration attempt with the non-preferred network is completed, the method further comprising:

- periodically causing the mobile station to reinitiate a registration attempt with a preferred network.

In a similar endeavor, Sorenson discloses a method of acquiring an alternate communication system upon failure of reverse link communication. Sorenson also discloses wherein the registration attempt with the non-preferred network is completed, the method further comprising:

- periodically causing the mobile station to reinitiate a registration attempt with a preferred network (col.10, lines 14-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a step of periodically re-attempt to register with a preferred network so that it could register with a preferred network.

Regarding claim 8, Huang discloses the method of claim 6 as described above. Huang, however, fails to disclose wherein rejecting the attempt comprises causing a transaction time out.

In a similar endeavor, Sorenson discloses a method of acquiring an alternate communication system. Sorenson further discloses wherein rejecting the attempt comprises causing a transaction time out (fig.3, box 318 and its descriptions).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include causing a transaction time out when attempting to reject so that the system could acquire a preferred network and make communication therewith.

Regarding claim 10, Huang discloses the method of claim 1 as described above. Huang, however, fails to disclose wherein determining whether a roaming mobile station is engaged in a voice or data session.

In a similar endeavor, Sorenson discloses a method of acquiring an alternate communication system. Sorenson also discloses determining whether a roaming mobile station is engaged in a voice or data session (col. 10, lines 4-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include determining whether a roaming mobile station is engaged in voice or data session so that the proper channel can be allocated to make communications with the mobile station.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Mittal et al (hereinafter Mittal) (US 2002/0160763 A1).

Regarding claim 5, Huang discloses the method of claim 1 as described above. Huang also teaches wherein determining whether the mobile station should be moved to another network (col. 3, line 57 – col. 4, line 33). The examiner notes that when the computer determines that another system is more preferable then it is switched to the preferred one, in which it means that the mobile station is being moved to another network.

Huang, however, fails to disclose updating files on the mobile station, including a preferred provider list.

In a similar endeavor, Mittal discloses an apparatus and method for providing operation parameters to a mobile station. Mittal also discloses updating files on the mobile station, including a preferred provider list (paragraph 0037).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention by adding the updating files on the mobile station so that the preferred provider list is always updated and assist in selecting a preferred network for the mobile station.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Seppanen et al (hereinafter Seppanen) (US – 5,903,832).

Regarding claim 11, Huang discloses the method of claim 1 as described above. Huang, however, fails to disclose whether a roaming mobile station is in an automatic network selection mode or a manual network selection mode.

In a similar endeavor, Seppanen discloses a mobile station having enhanced system selection capability. Seppanen also discloses determining whether a roaming mobile station is in an automatic network selection mode or a manual network selection mode (abstract, and col.6, line 62 – col.7, line 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the step of determining the selection mode of the mobile station so that it could select a network based on predetermined references.

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Allison et al (hereinafter Allison) (US 2003/012991 A1).

Regarding claim 12, Huang discloses the method of claim 1 as described above. Huang, however, fails to disclose invoking an Update Location message.

In a similar endeavor, Allison discloses a method and system for providing mobile location management services. Allison also discloses invoking an Update Location message on demand (paragraph 0047).


It would have been obvious to one of ordinary skill in the art at the time the invention was made to include an Update Location message so that the system knows the status of where the mobile station is located.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Cai whose telephone number is (571) 272-7798. The examiner can normally be reached on Monday-Friday; 9:00-6:00; alternating Friday off:

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Wayne Cai
Examiner
Art Unit 2681


ERIKA A. GARTY
PRIMARY EXAMINER